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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/727,203 | 12/03/2003 | Nancy L. Klodt | P06446US00 | 5137 |
| 22885 | 7590 | 03/28/2006 | EXAMINER | |
| MCKEE, VOORHEES & SEASE, P.L.C. 801 GRAND AVENUE SUITE 3200 DES MOINES, IA 50309-2721 | | | SUHOL, DMITRY | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3725 | |

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/727,203

Applicant(s)

KLODT, NANCY L.

Examiner

Dmitry Suhol

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haupt '620 in view of McAllister '153 and Greenberg '325. Haupt discloses an educational device containing most of the claimed elements including, with respect to claims 1, 8 and 13, a teaching aid body (1) having a top surface and opposite bottom surface (figure 2), the body defining a frame around an aperture (2) in the body (figures 1 and 2), educational information represented on the top surface of the body (figure 1), a replaceable name tag (3) positioned within the aperture of the body/replaceable name tag region (figures 1 and 2). The educational material being reading material, as required by claim 3, is shown in figure 1 as the word "pig". Decorative matching designs being on name tag (3) and the top surface of the body (1), as required by claims 4, 9 and 14-16, are shown in figure 1 with the words "pig" and pig design as well (where it is considered that as broadly claimed by the applicants a "pig" is the design element associated with a school, for instance a mascot). The name tag including educational material, as required by claims 5-6 and 8, is also shown in figure 1, as the word "pig". The educational material being located in a plurality of regions of the body, as required

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by claim 7, is shown in figure 1, where it can be seen that the word "pig" is at the top region of the body while the pig design is in the center region.

Haupt lacks the teaching of a bottom surface comprising a magnetic material as required by claims 1, 8 and 13 and the name tag comprising a paper medium as required by claims 1, 8 and 13. However, McAllister discloses an educational device, like that of Haupt, which teaches that it is known to provide such devices with a magnetic bottom surface for the purpose of attaching such a device to a metallic article (col. 1, lines 58-67), while Greenberg discloses an educational device which uses a body with an aperture (32) that receives various cards which teaches that it is known to manufacture such devices from a paper medium (col. 3, lines 15). Therefore it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to having manufacture the bottom surface of Haupt from a magnetic material for the purpose of attaching the device to a metallic surface. It would have been further obvious to manufacture element (3) of Haupt comprising a paper medium for the purpose of cost of manufacture and since Haupt clearly states that any materials of construction may be used in the manufacture of his device (page 1, lines 19-20).

Regarding a sleeve being attached to the bottom surface of the body, as required by claim 2, it would have been obvious to manufacture the device of Haupt with a sleeve portion attached to the bottom surface of the body instead of the back wall portion since the examiner takes official notice that such construction to hold one item in a body portion is well known in the art. Furthermore, it is considered that the attachment means for the name tag being a sleeve is an obvious choice of design as applicants

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clearly state that the name tag may be attached to the device in a variety of known ways (see applicants specification page 4, lines 29-30).

Furthermore, regarding the specific information carried by the body and the name tag, as required by claims 1, 3-9, 13-16, it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to provide the teaching aid with any of the claimed indicia since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of display/educational information does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. educational and design indicia/information) and the substrate (e.g. name tag and device body) which is required for patentability. Furthermore it is the position of the examiner that the decorative design and placement of the educational material as claimed is purely a design choice in that applicants do not disclose any advantage or critical need for the decorative design or the placement of the educational material (see applicants specification page 4, lines 28-31).

Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haupt '620 and McAllister '153, as stated above, and further in view of Miller '902. Haupt, as modified by McAllister, fails to explicitly teach a second replaceable name tag region as required by claim 10, the replaceable name tag region including a sleeve as required by claim 11 and a first and second sleeves for holding replaceable name tags as required by claim 12. However, Miller discloses a teaching aid like that of Haupt and McAllister which teaches that it is known to provide such aids with one or more sleeves/replaceable tag regions for holding tags (32) which match educational material on the body of the aid (figures 1, 4 and 6). Therefore it would have been obvious to manufacture the device of Haupt, as modified by McAllister, with one or more replaceable name tag regions/sleeves for the purpose providing a teaching aid with increasing complexity, especially since Haupt clearly states that multiple teaching topics are encompassed in his invention (lines 61-67).

Response to Arguments

Applicant's arguments filed 2/10/2006 have been fully considered but they are not persuasive. Applicants argue that the purpose/functionality/use of Haupt differs from applicants invention. In response the examiner points out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case the prior art is clearly capable of

performing the intended use. For example, claim 1 and associated portions of the specification clearly state that a possible use of applicants invention is to "...present different educational information where the replaceable name tag includes educational information", Haupt clearly fulfills such uses and therefore meets the claim limitations. Additionally, it should be restated that the indicia carried by the name tag and body portion is not patentable subject matter (see *In re Gulack*, 217 USPQ 401, (CAFC 1983)).


Applicants further argue that there is no reason to combine the references. In response the examiner points out that all three references are directed to educational devices in which a user must match a piece to a recess/aperture. Furthermore, McAllister '153 clearly improves on the device of Haupt by teaching the use of a magnetic portion which allows the device to be attached to a metallic article (col. 1, lines 9-20 and 58-67) so that a child may play with the educational device on a variety of surfaces found around the home.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Dmitry Suhol
Primary Examiner
Art Unit 3725

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